

U.S. Patent Application No. 10/088,750
Amendment After Final dated July 21, 2006
Reply to Office Action of April 25, 2006

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REMARKS/ARGUMENTS

Favorable reconsideration and continued examination of the present application are respectfully requested.

In the Office Action of April 25, 2006, claims 9, 17, 20, 24, 27, 30, and 31 were rejected. Claims 16, 22, 23, and 25 were objected to because they are dependent on a rejected claim. No claim was allowed. The applicants appreciate the Examiner's withdrawal of the rejections as indicated on pages 2-3 of the Office Action.

The applicants would like to thank Examiner Kam for the courtesy of a telephone interview on July 19, 2006, with applicants' representative, Dinh Nguyen (Reg. No. 54,923). During the interview, the claim amendments presented herein were discussed (the Examiner was provided in advance with an unofficial copy of the Amendment) and the Examiner stated that she believed that the claim amendments would overcome the outstanding rejections in the application.

The amendment to the claims is editorial in nature and/or further defines what applicants regard as their invention.

In particular, claims 20, 23 and 30 are amended. New claim 32 is added. Claims 1-4, 12, 14, 18, 19, 24, 28, 29 and 31 are canceled by way of this Amendment. Therefore, claims 9, 16, 17, 20, 22, 23, 25, 27, 30 and 32 are pending.

Claims 20 and 30 are amended by deleting item 3) from the claims, as discussed herein. Claims 20 and 30 are also amended by inserting item 2) from claim 25, which the Examiner considers allowable subject matter. Claims 20, 23, and 30 are also amended to correct typographical errors, as suggested by the Examiner in the interview on July 19, 2006. New claim

U.S. Patent Application No. 10/088,750
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32 corresponds to claim 25, which the Examiner considers allowable subject matter.

Claims 1-4, 12, 14, 18, 19, 28 and 29 are canceled by way of this Amendment. These claims are non-elected claims that were withdrawn from consideration following a restriction requirement in the Office Actions of May 19, 2004 and November 16, 2004, which restriction was made final in the Office Action of January 26, 2005. Applicants reserve the right to file a divisional application directed to the subject matter of the canceled claims.

The claim amendments presented are limited to those that resolve issues of the written description requirement raised by the Examiner in the Office Action. The claim amendments were not presented earlier because the applicants relied on bona fide alternative arguments and amendments in their earlier response to traverse the rejections made in the application. To expedite prosecution, the application is further amended in view of the Examiner's further comments in the Final Office Action, the Advisory Action, and the interview on July 19, 2006. No new questions of patentability are raised by these amendments and no need for further searching is necessitated. The amendment places the application in condition for allowance or at the very least in better form for appeal. Accordingly, entry of the amendments under 37 CFR 1.116(c) is respectfully requested.

Rejection of claims 9, 17, 24, 27, 30, and 31 under U.S.C. §112, first paragraph

At page 3 of the Office Action dated April 25, 2006, the Examiner rejects claims 9, 17, 24, 27, 30 and 31 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement (it appears that the Examiner intended to include claim 20 in this rejection). Particularly, the Examiner alleges that the present application does not describe a

U.S. Patent Application No. 10/088,750
Amendment After Final dated July 21, 2006
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genus of variants for a polynucleotide sequence that is substantially identical to the base sequence of SEQ ID NOs: 1-6 or 7 and having a function for promoting translation activity, or a structure homologous to the structures of PK I, II and III in the RNA higher-order structure. Further, the Examiner alleges that the present application does not describe the structures that are homologous to the structures of PK I, II and III and that without guidance on the structure to function or activity relationship for variants of SEQ ID NOs: 1-7, one skilled in the art would not know which nucleotides in the sequences of SEQ ID NOs: 1-7 are essential for its translation activity, and how to identify a functional polynucleotide from numerous polynucleotides having at least 50% homology to SEQ ID NOs: 1-7. For the following reasons, this rejection is respectfully traversed.

It appears from this rejection, that the Examiner is objecting to item 3) as recited in claims 20 and 30 ("a base sequence substantially identical to the base sequence of 1) and having the at least PK (pseudoknot) I, II and III structures or structure homologous thereto"). While the applicants disagree with the Examiner, the claims have been amended in order to expedite prosecution of the present application. In particular, item 3) of claims 20 and 30 are now deleted. Therefore, this rejection should be withdrawn.

Objection to claims 16, 22, 23, and 25

The applicants appreciate the Examiner stating in the Office Action dated April 25, 2006, that claims 16, 22, 23, and 25 are objected to only because the claims are dependent from rejected claim 20. The applicants respectfully submit that claims 9, 16, 17, 20, 22, 23, 25, 27, and 30, and new claim 32 (as discussed below) are also in condition for allowance.

U.S. Patent Application No. 10/088,750
Amendment After Final dated July 21, 2006
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**Patentability of claims 9, 16, 17, 20, 22, 23, 25, 27, 30, 31 and new claim 32, in view of the
Advisory Action**

In the Advisory Action dated June 20, 2006, the Examiner states that if the After-final Amendment dated June 7, 2006 were entered, the Amendment would overcome the rejection of claims 9, 16, 20, 22, 23 and 27. However, this Amendment was not entered because the Examiner indicates that it would conflict with some of the dependent claims.

In particular, the Examiner alleges that claim 24 would be in conflict with the proposed amendment to claim 20. Claim 24 is now canceled.

The Examiner also alleges that claim 25 would also be in conflict with the proposed amendment to claim 20. Claim 25, was previously objected to as it was indicated to contain allowable subject matter. The subject matter of claim 25 is now incorporated into claim 20. Therefore, this amendment obviates this particular conflict.

The Examiner also alleges that claim 31, would be in conflict with the proposed amendment to claim 30. Claim 31 is now canceled.

The Examiner alleges that claim 30 would still be rejected under 35 U.S.C. § 112, first paragraph. Claim 30 has been amended to delete "is obtained by changing a combination of base pairs that make up" at lines 6-7, in response to the Examiner's concerns regarding the 112, first paragraph issue.

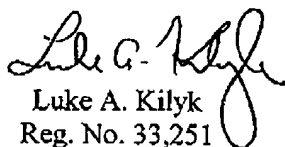
New claim 32 is added, which contains the allowable subject matter of claim 25. Claim 32 is dependent on claim 30 instead.

U.S. Patent Application No. 10/088,750
Amendment After Final dated July 21, 2006
Reply to Office Action of April 25, 2006

Conclusion

If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 50-0925. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,


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